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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,913	12/31/2001	Ulf Landegren	LAND DIV	5983
466	7590	08/09/2004	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			SAKELARIS, SALLY A	
			ART UNIT	PAPER NUMBER

1634

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/029,913

Applicant(s)

LANDEGREN, ULF

Examiner

Sally A Sakelarlis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The applicant should note that the case has been transferred to another examiner who has issued a second Non-final action herein.

This action is written in response to applicant's correspondence submitted 5/24/2004. Claim 1 has been amended, claims 14-21 have been canceled, and no claims have been added. Claims 1-13 are pending. Applicant's amendments and arguments have been thoroughly reviewed, but are not persuasive for the reasons that follow. Any rejections not reiterated in this action have been withdrawn as necessitated by applicant's amendments to the claims. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. **This action is Non-FINAL.**

### ***Terminal Disclaimer***

The terminal disclaimer filed on 5/24/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 5,871,921 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 1-13 are indefinite over the recitation of the letters A through F. It is unclear in claim 1 to what the letters A through F refer. It is unclear if there are different solid phase anchors known as “A” or “A through E” and how a solid phase anchor selected from “A through E” could also be a “cleavable B”, “detectable function C”, or a “dissociable D, F and detectable function C”. It is unclear to what applicant is referring in their recitation of the letters A through F.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

It should be noted that: during examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art(See MPEP 2111.02).

In the present claim 1, the recitation of “detecting, quantifying, and distinguishing between sequence variants with regards to one or several target sequences in a sample” is not deemed to give life, meaning and vitality to the claim since it does not recite essential steps and prefaces a body that is a self-contained description that does not depend on the preamble for completeness.

2. Claims 1, 5, 6, and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nilsson et al.(Science, Vol. 265, pages 2085-2088 September 30, 1994).

With regard to claim 1, a cleavable, detectable function is broadly interpreted to include anything that is removable and detectable. For example, a nucleotide that is exonuclease-treated and detected is interpreted as meeting this claim limitation. Nilsson et al. teaches a method of detecting a target nucleic acid sequence in a sample by contacting the sample with a detectable probe to hybridize the probe to the target sequence, and detecting the hybridized probe, said probe has two free nucleic acid end parts which are at least partially complementary to and capable of hybridizing to two at least substantially neighboring regions of the target sequence (Figure 4), comprising the following steps:

- a) hybridizing the probe ends to the target sequence under hybridization conditions (Figure 4);
- b) covalently connecting the ends of the hybridized probe with each other to form a circularized structure;(Figure 4)
- c) cleaving the cleavable function (e.g. washing under denaturing conditions in this case) (Figure 4), characterized in that the probe is provided with a cleavable or dissociable detectable function (Figure 4), and the method comprising the further steps of:
  - d) separating detectable functions no longer linked to the solid phase (Figure 4);
  - e) detecting the presence and, if desired, location of the remaining probe as indicative of the presence of the target nucleic acid sequence (Figure 4).

With regard to claims 5 and 6, Nilsson et al. teaches that the detectable function is dissociable by being provided either on a further circularizable probe or on a target-specific probe (Figure 4).

With regard to claim 9, Nilsson et al. further teaches the performance covalent connection of the probe ends by enzymatic or chemical ligation (Figure 4).

With regard to claim 10, Nilsson et al. teaches the DNA or RNA as target molecule (Figure 4).

With regard to claims 11-13, Nilsson et al. teaches the immobilization of oligonucleotide probes as well as the target sequence to a solid phase (Figure 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilsson et al. (Science, Vol. 265, pages 2085-2088 September 30, 1994) in further view of Urdea et al. (US Patent 5,124,246).

With regard to claim 1, Nilsson et al. teach a cleavable, detectable function is broadly interpreted to include anything that is removable and detectable. For example, a nucleotide that is exonuclease-treated and detected is interpreted as meeting this claim limitation. Nilsson et al. teaches a method of detecting a target nucleic acid sequence in a sample by contacting the sample with a detectable probe to hybridize the probe to the target sequence, and detecting the hybridized probe, said probe has two free nucleic acid end parts which are at least

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partially complementary to and capable of hybridizing to two at least substantially neighboring regions of the target sequence (Figure 4), comprising the following steps:

- a) hybridizing the probe ends to the target sequence under hybridization conditions (Figure 4);
- b) covalently connecting the ends of the hybridized probe with each other to form a circularized structure;(Figure 4)
- c) cleaving the cleavable function (e.g. washing under denaturing conditions in this case) (Figure 4), characterized in that the probe is provided with a cleavable or dissociable detectable function (Figure 4), and the method comprising the further steps of:
  - d) separating detectable functions no longer linked to the solid phase (Figure 4);
  - e) detecting the presence and, if desired, location of the remaining probe as indicative of the presence of the target nucleic acid sequence (Figure 4).

With regard to claims 5 and 6, Nilsson et al. teaches that the detectable function is dissociable by being provided either on a further circularizable probe or on a target-specific probe (Figure 4).

With regard to claim 9, Nilsson et al. further teaches the performance covalent connection of the probe ends by enzymatic or chemical ligation (Figure 4).

With regard to claim 10, Nilsson et al. teaches the DNA or RNA as target molecule (Figure 4).

With regard to claims 11-13, Nilsson et al. teaches the immobilization of oligonucleotide probes as well as the target sequence to a solid phase (Figure 4).

Nilsson et al. do not teach the detectable function is cleavable by cleaving a cleavable linker located on the same probe end as the detectable function with regard to claim 2.

However, Urdea et al. teach the detectable function is cleavable by cleaving a cleavable linker located on the same probe end as the detectable function (Figures 3-2 and Column 12, lines 49 to column 13, line 43).

Nilsson et al. also do not teach the method with branched or bifurcated probes with regards to claims 3 and 4.

However, Urdea et al. teaches a circularizable probe comprising two free cleavable or detectable nucleic acid end parts which are linear, branched or bifurcated and are capable of hybridizing to two at least substantially neighboring regions of a target sequence (abstract, examples 1, 2 and 3).

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to substitute the branched or bifurcated probes of Urdea et al. in the method of Nilsson et al. since Urdea et al state, "suitable cleavable linker molecules may be incorporated into the multimers at predetermined sites for the purpose of analyzing the structure of the multimer or as a means for releasing predetermined segments (such as the portion of the multimer that binds to the oligonucleotide) (Column 12, lines 49-55)99. Moreover, Urdea et al. states "The multimers may be used in essentially any of the known nucleic acid hybridization formats, such as those in which the analyte is bound directly to a solid phase or a sandwich hybridization in which the analyte is bound to an oligonucleotide that is in turn bound to a solid phase (Column 13, lines 56-61)". An ordinary practitioner would have been motivated to combine and substitute the branched or bifurcated probes of Urdea et al. into the method



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of Nilsson et al. in order to achieve the express advantages, as noted by Urdea et al., of improving the sensitivity of nucleic acid based assay by applying multimers, which may be used in essentially any of the known nucleic acid hybridization formats, such as those in which the analyte is bound directly to a solid phase or sandwich hybridization in which the analyte is bound to an oligonucleotide that is in turn bound to a solid phase.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilsson et al.(Science, Vol. 265, pages 2085-2088 September 30, 1994) in further view of Birkenmeyer et al.(US Patent 5,427,930).

While the teachings of Nilsson et al. are summarized above, the reference does not teach the interspace between probe ends which is filled by an extension reaction prior to covalently interconnecting the probe ends.

However, Birkenmeyer et al. teaches the interspace between probe ends which is filled by an extension reaction prior to covalently inter-connecting the probe ends (abstract and example 1). It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to substitute gap filling ligase chain reaction in the method of Nilsson et al. since Birkenmeyer et al. states "it is therefore a primary object of the present invention to improve the sensitivity of nucleic acid based assay by decreasing the occurrence of target independent ligation which causes falsely positive background signal. This object is met in the present invention by modifying at least one probe end so that when hybridized with its complementary probe, the resulting duplex is not "blunt-ended" (i.e. ligatable) with respect to the partner complementary probe duplexes. After hybridization to the target, the modified ends are

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“corrected” in a target dependent fashion to render the adjacent probes ligatable. Several features of the probes and the associated target sequences taught in this application makes this task particularly elegant (column 2, lines 28-42)". An ordinary practitioner would have been motivated to combine gap filling ligase chain reaction into the method of Nilsson et al. in order to achieve the express advantages, as noted by Birkenmeyer et al., of improving the sensitivity of nucleic acid based assay by decreasing the occurrence of target independent ligation.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally A Sakelaris whose telephone number is 571-272-0748. The examiner can normally be reached on M-Fri, 9-6:30 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\* Sally Gue  
8/5/04

  
JEFFREY FREDMAN  
PRIMARY EXAMINER  
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